



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/110,667	07/07/1998	PETER C. BOYLAN III	UV-76	4967

7590 08/26/2004

G VICTOR TREYZ
FISH & NEAVE
1251 AVENUE OF THE AMERICAS
NEW YORK, NY 100201104

EXAMINER

HUYNH, SON P

ART UNIT	PAPER NUMBER
----------	--------------

2611

24

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/110,667

Applicant(s)

BOYLAN III ET AL.

Examiner

Son P Huynh

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 133-136 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 133-136 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on May 27, 2004 have been fully considered but they are not persuasive.

Applicant argues Kikinis does not show or suggest displaying a local advertisement that is distinct from but corresponds to the global advertisement selected by the user; displaying local advertisements that only have local information that is specific to the particular geographic region for which it is designated. This argument is respectfully traversed.

It is noted that the limitation specification discloses a typical global advertisement might be for a certain brand of automobile. A typical local advertisement for one region might be for an automobile dealership, because automobile dealerships usually serve only certain geographic regions (pages 17, lines 26).

Kikinis discloses displaying an advertisement for certain brand of automobile, an icon or emblem may be presented in each frame at a particular position in the frame (col. 6, lines 50-63). When the icon for a certain brand of automobile (e.g. BMW) is selected, the BMW web page 71 is displayed. The web page includes information such as location near the viewer where a demonstration drive may be accomplished and company representatives may be interviewed, and much more

Art Unit: 2611

(col. 8, lines 23-37). Thus, the local advertisement is distinct from but correspond to the global advertisement selected by the user in response to receiving user selection (the information in the web such as location near the viewer.... is distinct from brand of automobile (i.e. BMW) but correspond to automobile), the local advertisement displaying only local information that is specific to the particular geographic region for which it is designated (displaying information of location near the viewer....).

Furthermore, the limitation of "the local advertisement displaying only local information that is specific to the particular geographic region for which it is designated" is disclosed by Alexander (see col. 32, lines 7-54) or disclosed by Burns (figure 2a).

For the reason given above, rejection on claim 133-136 is discussed below.

Claims 1-132 have been cancelled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

Art Unit: 2611

said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 133-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al. (US 6,177,931), and in view of Kikinis (US 5,929,849).

Regarding claim 133, Alexander teaches a system in which local and global advertisements are distributed to user television equipment (viewer's television system) on which an interactive television program guide is implemented, comprising:

means (data source such as Internet – col. 8, lines 18-35) for distributing global and local advertisements to the user television equipment, wherein the local advertisements are designated for display in a particular geographic region (figure 1 and col. 32, lines 23-60);

means (EPG) for using the interactive television program guide to display the global advertisement (in Ad window – figure 1);

means (remote controller 26 – figure 2) for receiving a user selection of the global advertisement.

means for displaying a local advertisement, the local advertisement displaying only local information (e.g. the 3 Burger King s in the viewer's local area – col. 32, lines 44-45) that is specific to the particular geographic region for which it is designated (col. 32, lines 35-50). Alexander further discloses Ad window is interactive to allow user to select the advertisement for more information (col. 13,

Art Unit: 2611

lines 54-55). However, Alexander does not specifically disclose local advertisement is distinct but corresponds to the global advertisement selected by the user in response to receiving the user selection.

Kikinis teaches displaying a local advertisement distinct but corresponds to the global advertisement selected by the user in response to receiving the user selection (information about location near the viewer where a demonstration drive may be accomplished and company representative may be interviewed,.... (col. 8, lines 23-37) is distinct but correspond to brand of automobile (BMW) by the user in response to receiving the user selection of the icon – col. 8, lines 23-37 and figures 2A-2C). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Alexander to use the teaching as taught by Kikinis in order to efficiently provide local advertisements to user via global advertisements.

Regarding claim 134, the limitations of the method being claimed respectively correspond to the limitations of the system being claimed in claim 133 and are analyzed as discussed with respect to the rejections of claim 133.

Regarding claim 135, the limitations being claimed correspond to the limitations being claimed in claim 133 and are analyzed as discussed with respect to the rejection of claim 133.

Art Unit: 2611

Regarding claim 136, the limitations of the claims are respectively directed toward embody the method of claim 133 in a "machine readable medium." It would have been obvious to embody the procedures of Alexander and Kikinis as discussed with respect to claim 133 in a "machine readable medium" in order that a processor could automatically perform the instructions.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Slezak (US 6,006,257) discloses if a viewer selects an action movie as the primary, if at some point a truck is highlighted in a scene, secondary programming material can be interleaved which presents an advertisement related to a local truck dealer carrying a similar model of truck being show in the primary programming (col. 4, lines 15-20).

Martin et al. (US 6,191,780 teaches customizable multimedia segment structure. Walker (US 6,381,582) teaches method and system for processing payments for remotely purchased goods.

Hite (US 5,774,170) teaches system and method for delivering targeted advertisements to consumers.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2611

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son P Huynh whose telephone number is 703-305-1889. The examiner can normally be reached on 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Son P. Huynh
August 13, 2004

A handwritten signature in black ink, appearing to read 'Son P. Huynh', is written over two horizontal lines.

HAITRAN
PATENT EXAMINER